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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/711,720	09/30/2004	Fred Bishop	03292.101090.28	5719
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EXAMINER COPPOLA, JACOB C				
ART UNIT 4143		PAPER NUMBER		
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/711,720

Applicant(s)

BISHOP ET AL.

Examiner

JACOB C. COPPOLA

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 23 February 2007.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-6, 8 and 9 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-6, 8 and 9 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 30 September 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date 30 September 2004, 11 October 2004, 13 October 2004, 06 April 2005, 08 April 2005, and 23 August 2007.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date: _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

Status of Claims

1. This action is in reply to the Preliminary Amendment filed on 23 February 2007.
2. Claim 7 has been canceled.
3. Claims 1-6, 8, and 9 are currently pending and have been examined.

Information Disclosure Statement

4. Acknowledgement is hereby made of receipt of Information Disclosure Statement(s) filed by applicant on 30 September 2004, 11 October 2004, 13 October 2004, 06 April 2005, 08 April 2005, and 23 August 2007.

Due to the excessively lengthy Information Disclosure Statement submitted by applicant, the examiner has given only a cursory review of the listed references. In accordance with MPEP 609.04(a), applicant is encouraged to provide a concise explanation of why the information is being submitted and how it is understood to be relevant. Concise explanations (especially those which point out the relevant pages and lines) are helpful to the Office, particularly where documents are lengthy and complex and applicant is aware of a section that is highly relevant to patentability or where a large number of documents are submitted and applicant is aware that one or more are highly relevant to patentability. Applicant is required to comply with this statement for any non-English language documents. See 37 CFR § 1.56 Duty to Disclose Information Material to Patentability.

Claim Rejections - 35 USC § 112

5. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

6. Claims 1 and 8 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

7. As per Claim 1, claim suggests adding data sets *at the transaction device*. Examiner is unable to determine the metes and bounds of Applicants' invention because of the phrase "at the transaction device". This phrase implies that the data sets are being added to the database at a specified location, here the location being the transaction device. Examiner recommends changing "at" to "to". Appropriate correction is required.

8. Claim 8 recites the limitation "said selection apparatus" in line 1 of the claim. There is insufficient antecedent basis for this limitation in the claim.

9. As per Claim 8, the limitation "selection apparatus" could only be found by Examiner in claim 7 of the original claim set, and therefore there is a lack of antecedent basis for this limitation in all of the present claims under examination. Furthermore, claim 8 claims dependency to claim 15. This is obviously a "typo" since there are only 8 claims in the current claim set, ending with claim 9. Since "selection apparatus" could only be found in claim 7 of the original claim set, Examiner has determined that claim 8 should claim dependency from claim 7 and should read "The system of claim 7", and since claim 7 has been cancelled the Examiner is unable to determine the metes and bounds of Applicants' claimed invention. For the purposes of this examination, Examiner will assume dependency from claim 1. Appropriate correction is required.

Claim Rejections - 35 USC § 103

10. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

11. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

12. **Examiner's Note:** The Examiner has pointed out particular references contained in the prior art of record within the body of this action for the convenience of the Applicant. Although the specified citations are representative of the teachings in the art and are applied to the specific limitations within the individual claim, other passages and figures may apply. Applicant, in preparing the response, should consider fully the entire reference as potentially teaching all or part of the claimed invention, as well as the context of the passage as taught by the prior art or disclosed by the Examiner.

13. Claims 1, 2, and 9 are rejected under 35 U.S.C. 103(a) as being unpatentable over Frieden et al. (U.S. 6,480,100 B1), in view of Maritzen et al. (U.S. 2002/0026419 A1), hereinafter referred to as Frieden and Maritzen, respectively.

14. As per claims 1, 2, and 9, Frieden teaches the limitations:

- *adding to a database ("data storage member"), a first data set of a first format at the transaction device ("Data representing selected information may be written to...the RFID tag"), wherein said first data set is owned by said first data set owner (see at least column 3, lines 63-67, column 4, lines 55-67, and column 5, lines 1-16);*
- *adding to a database, a second data set of a second format at the transaction device, wherein said second data set is owned by said second data set owner (see at least column 3, lines 63-67, column 4, lines 55-67, and column 5, lines 1-16), wherein*
- *said first owner is distinct from said second owner, and said first format is different from said second format (see at least column 3, lines 63-67), wherein*
- *said first data set is stored in accordance with said first format, and said second data set is stored in accordance with said second format (see at least column 3, lines 63-67).*

Frieden, as shown, does not disclose the following limitation:

- *enrolling a first data set owner in multiple transaction accounts and a second data set owner in multiple transaction accounts in association with a transaction device program;*

Maritzen, however, in at least paragraph [0016] discloses a transaction and information processing clearing house (TIPCH) that "develops and maintains permanent relationships with financial and mortgage institutions, credit providers, department store chains, government entities and the like that will allow direct secure access to their information and account databases". Therefore, it would have been obvious to one of ordinary skill in the art, at the time the invention was made, to combine the TIPCH taught by Maritzen with the multiple tag users taught by Frieden. One would have been motivated to do so because Maritzen in at least paragraph [0013] teaches "a need exists for methods of increasing the availability of account and financial information and transaction capability to a user". Frieden, further, does not disclose the following limitations:

- *facilitating selection of said first data set on said database using a first secondary identifier indicia, said first secondary identifier indicia correlated to said first data set, and*
- *completing a transaction request using said first data set*

- *facilitating selection of said second data set on said database using a second secondary identifier indicia, said second secondary identifier indicia correlated to said second data set, and*
- *completing said transaction request using said second data set.*

Maritzen, however, in at least paragraph [0070] discloses, "a unique identifier that associates the specific device with the account", and further, in paragraph [0072], "credit and debit accounts for automatic payments on selected accounts are also determined". Ergo, Maritzen is teaching a system in which a user utilizes a device to communicate with a clearinghouse regarding "payment to" and "payment from" multiple accounts. An obvious modification, for one of ordinary skill in the art, would be to have multiple unique identifiers, one for each of the multiple accounts disclosed by Maritzen. Therefore, it would have been obvious to one of ordinary skill in the art, at the time the invention was made, to combine the integrated account system and unique identifier, taught by Maritzen, with the assigned portion of tag memory taught by Frieden. One would have been motivated to do so because Maritzen in paragraph [0013] teaches "a need exists for methods of increasing the availability of account and financial information and transaction capability to a user".

15. Claims 3 and 4 are rejected under 35 U.S.C. 103(a) as being unpatentable over Frieden/Maritzen, in further view of Deo et al. (U.S. 5,721,781 A).

16. As per claims 3 and 4, the combination of Frieden and Maritzen disclose the limitations of claim 1 as described above. Frieden does not explicitly teach *verifying said first secondary identifier indicia or authorizing a transaction request relative to said first data set*. Deo, however, in at least Figure 8 and column 5, line 57 through column 6, line 6 discloses a method, using digital certificates, for authenticating identification of multiple applications on a smart card and a method for authorizing transactions engaged by a smart card. Therefore, it would have been obvious to one of ordinary skill in the art, at the time of the invention, to add to the teachings of Frieden and Maritzen (in particular, the partitioning of capacity taught by Frieden), this method of "multiple-identifier" verification and transaction authorization. One

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would have been motivated to do so in order to provide a level of security for financial transactions, as is customary in the industry (see Maritzen, paragraph [0013]).

17. Claims 5, 6, and 8 are rejected under 35 U.S.C. 103(a) as being unpatentable over Frieden/Maritzen, in further view of Russell et al. (U.S. 2004/0044627 A1), hereinafter referred to as Russell.

18. As per claims 5, 6, and 8, the combination of Frieden and Maritzen disclose the limitations of claim 1 as described above.

Frieden does not explicitly disclose *completing a transaction request using said first data set comprises allocating a first portion of said transaction request to said first data set for transaction completion and completing a transaction request using said second data set, wherein a second portion of said transaction request is allocated to said second data set for transaction completion*. Russell, however, in at least paragraph [0037] teaches, "the payer account data might specify that a certain percentage of the payment be funded from a specified checking account and the balance be funded from a specified credit-card account". Therefore, it would have been obvious to one of ordinary skill in the art, at the time the invention was made, to modify the method disclosed by Frieden/Maritzen with the allocation method taught by Russell. One would have been motivated to do so because Maritzen in at least paragraph [0013] teaches "a need exists for methods of increasing the availability of account and financial information and transaction capability to a user".

Double Patenting

19. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the

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conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

20. Claim 1 is rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claim 1 of U.S. Patent No. 7,268,668, in view of Maritzen.

Furthermore, claim 1 of Patent No. 7,268,668 contains the limitations *a method for facilitating the management of a plurality of data sets on a transaction device, the method comprising the steps of: enrolling a first data set owner in multiple transaction accounts and a second data set owner in multiple transaction accounts in association with a transaction device program; adding to a database, a first data set of a first format at the transaction device, wherein said first data set is owned by said first data set owner; adding to a database, a second data set of a second format at the transaction device, wherein said second data set is owned by said second data set owner, wherein said first owner is distinct from said second owner, and said first format is different from said second format, wherein said first data set is stored in accordance with said first format, and said second data set is stored in accordance with said second format.* Claim 1 of Patent No. 7,268,668 does not have the limitation *facilitating selection of said first data set on said database using a first secondary identifier indicia, said first secondary identifier*

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indicia correlated to said first data set, and completing a transaction request using said first data set.

Maritzen, however, as described above, teaches *facilitating selection of said first data set on said database using a first secondary identifier indicia, said first secondary identifier indicia correlated to said first data set, and completing a transaction request using said first data set.* Therefore, it would have been obvious to one of ordinary skill in the art, at the time the invention was made, to combine the limitations from Patent No. 7,268,668 with the limitations taught by Maritzen. One would have been motivated to do so because Maritzen in at least paragraph [0013] teaches "a need exists for methods of increasing the availability of account and financial information and transaction capability to a user while providing secure network".

Conclusion

21. Any inquiry of a general nature or relating to the status of this application or concerning this communication or earlier communications from the Examiner should be directed to **Jacob C. Coppola** whose telephone number is **571.270.3922**. The Examiner can normally be reached on Monday-Friday, 9:30am-5:00pm. If attempts to reach the examiner by telephone are unsuccessful, the Examiner's supervisor, **JAMES A. REAGAN** can be reached at **571.272.6710**.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://portal.uspto.gov/external/portal/pair> <<http://pair-direct.uspto.gov> >. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at **866.217.9197** (toll-free).

Any response to this action should be mailed to:

Commissioner of Patents and Trademarks

Washington, D.C., 20231

or faxed to **571-273-8300**.

Hand delivered responses should be brought to the **United States Patent and Trademark Office Customer Service Window**:

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401 Dulany Street

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/Jacob C Coppola/ Examiner, Art Unit 4143

February 11, 2008

/James A. Reagan/Supervisory Patent Examiner, Art Unit 4143